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09/192,583	11/17/1998	TETSURO MOTOYAMA	5244-0084-2X	9978

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EXAMINER
HO, CHUONG T

ART UNIT	PAPER NUMBER
2616	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	09/192,583	MOTOYAMA, TETSURO
	Examiner	Art Unit	
	CHUONG T. HO	2616	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>01 August 2007</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1,2,8,10,11,13-17,23,24,30,32,33,35-39,45-48 and 50-52</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1, 2, 8, 10, 11, 13-17, 23, 24, 30, 32, 33, 35-39, 45-48, and 50-52</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

     1.☐ Certified copies of the priority documents have been received.

     2.☐ Certified copies of the priority documents have been received in Application No. _____.

     3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date <u>08/01/07</u>.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

1.   The amendment filed 06/04/07 have been entered and made of record.

2.   Applicant's arguments filed 06/04/07 have been fully considered but they are not

persuasive.

In the page 13, lines 20-23, the applicant alleged that "U.S.Patent No. 6,522,421

fails to disclose the step of determining, by the computer, whether a content of the

received message is intended to be read or viewed by a user, or provides an instruction

to an attached printing device associated with the computer by detecting the

characteristic of the message, wherein the received message does not include print

data to be printed by the attached printing device and the instruction is unrelated to

printing of data included in or attached to the recited message".

The examiner respectfully disagrees. In response to applicant's arguments

against the references individually, one cannot show nonobviousness by attaching

references individually where the rejections are based on combinations of references.

See In re Keller, 642F. 2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800

F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant obviously attacks references

individually without taking into consideration based on the teaching of combinations of

references as show below.

Lazaridis et al. discloses receiving an electronic mail message by a computer;

determining, by the computer, whether a content of the message (the word "instruction"

is the characteristic of the e-mail message) is intended to be read or viewed by a user

(user's desktop system 10) or provided an instruction to an attached printer device (col.

3, lines 52-53, attached printer, col. 6, line 10, line 25, printer) associated with the

computer by detecting a characteristic of the e-mail, wherein the received message

does not include print data to be printed by the attached printing device and the

instruction is unrelated to printing of data included in or attached to the received

message (see col. 8, lines 4-10, the message characteristics ("instruction") that

determine whether a message is to be redirected to attached printer);

Claim Objections

3.   Claim 16 is objected to because of the following informalities: Claim 16 is

depend on the canceled claim 12. Appropriate correction is required.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 08/01/07 was filed after

the mailing date of the non-final action on 03/12/07. The submission is in compliance

with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is

being considered by the examiner.

4.   Claims 1, 2, 8, 10, 11, 13-17, 23, 24, 30, 32, 33, 35-39, 45-48, and 50-52 are

currently pending.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained.though the invention is not identically disclosed
> or described as set forth in section 102 of this title, if the differences between the
> subject matter sought to be patented and the prior art are such that the subject
> matter as a whole would have been obvious at the time the invention was made
> to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was
> made.

6.   Claims 1-4, 8-10, 12-15, 23-26, 31-32, 34-37, 45-46, 48, 50-52 are rejected

under 35 U.S.C. 103(a) as being unpatentable over Lazaridis et al. (U.S.Patent No.

6,219,694 B1) in view of Chapman et al. (U.S.Patent No. 6,522,421 B2).

In the claim 1, Lazaridis et al. discloses determining a system for pushing

information from a host system (a computer) to a mobile data communication device (a

business device) upon sensing a triggering event is disclosed (see abstract). A

redirector program operating at the host system (a computer) enables a user to

continuously redirect certain user's mobile data communication device upon detecting

the one or more user-defined triggering events has occurred (see abstract); A list of

message characteristics that determine whether a message is to be redirected. If

activated, the preferred list mode causes the redirector program 12 to operate like a

filter, only redirecting certain user data items based on whether the data item was sent

from a sender on the preferred list or has certain message characteristics that if present

will trigger or suppress redirection of the message (see col. 8, lines 9-11); comprising:

- Receiving an electronic mail message by a computer; determining, by the
  computer, whether a content of the message (the word "instruction" is the
  characteristic of the e-mail message) is intended to be read or viewed by a user
  (user's desktop system 10) or provided an instruction to an attached printer
  device (col. 3, lines 52-53, attached printer, col. 6, line 10, line 25, printer)
  associated with the computer by detecting a characteristic of the e-mail, wherein
  the received message does not include print data to be printed by the attached
  printing device and the instruction is unrelated to printing of data included in or

attached to the received message (see col. 8, lines 4-10, the message

characteristics ("instruction") that determine whether a message is to be

redirected to attached printer);

- transmitting a communication from the computer (user's desktop system 10) to

  the attached device (a mobile data communication device), if the determining

  step determines that the received message provides the instruction (col. 8, lines

  5-10, the message characteristics) to the attached printing device (col. 3, lines

  52-53, attached printer, col. 6, line 10, line 25, printer) (see abstract, determining

  a system for pushing information from a host system (a computer) to a mobile

  data communication device (a business device) upon sensing a triggering event

  is disclosed (see abstract). A redirector program operating at the host system (a

  computer) enables a user to continuously redirect certain user's mobile data

  communication device upon detecting the one or more user-defined triggering

  events has occurred (see abstract); (see col. 8, lines 9-11, a list of message

  characteristics that determine whether a message is to be redirected. If activated,

  the preferred list mode causes the redirector program 12 to operate like a filter,

  only redirecting certain user data items based on whether the data item was sent

  from a sender on the preferred list or has certain message characteristics that if

  present will trigger or suppress redirection of the message);

- operating the processor of the attached device (a mobile data communication

  device) in response to the transmitted communication (once the message (A or

  B) is received by the mobile device 24), the outer envelope B is removed and the

original message A is placed in the secondary memory store within the mobile

device 24. By repacking and removing the outer envelope in this manner, the

present invention causes the mobile computer 24 to appear to be at the same

physical location as the host system 10, thus creating a transparent system);

However, Lazaridis et al. is silent to disclosing that the attached printing device

including a processor.

Chapman (U.S.Patent No. 6,522,421 B2) discloses that the attached printing device

including a processor (figure 1, copier / printer 15', 15", col. 2, lines 58-60,

microprocessors), operating the processor of the attached printing device in response to

the transmitted communicaiton (col. 3, lines 15-17, lines 57-58, the email message or

electronic mail may be transmitted by telephone lines to computers that are coupled to

the printers) so that the printer will perform a print job and email back status information

(col. 3, lines 5-6, a method of automatically returning status and error information from a

printer using email).

Thus, it would have been obvious to one of ordinary skill in the art at the time of the

invention to modify the system of Lazaridis with the teaching of Chapman to provide the

attached printing device including a processor in order to diagnose of troubles in such

devices. Therefore, it would have enabled the user to be informed of the status of print

job.

7.   In the claim 23, Lazaridis et al. discloses determining a system for pushing

information from a host system (a computer) to a mobile data communication device (a

business device) upon sensing a triggering event is disclosed (see abstract). A

redirector program operating at the host system (a computer) enables a user to
continuously redirect certain user's mobile data communication device upon detecting
the one or more user-defined triggering events has occurred (see abstract); A list of
message characteristics that determine whether a message is to be redirected. If
activated, the preferred list mode causes the redirector program 12 to operate like a
filter, only redirecting certain user data items based on whether the data item was sent
from a sender on the preferred list or has certain message characteristics that if present
will trigger or suppress redirection of the message (see col. 8, lines 9-11); comprising:

- Means, associated with a computer, for receiving an electronic mail message;
  means for determining whether a content of the message (the word "instruction"
  is the characteristic of the e-mail) is intended to be read or viewed by a user
  (user's desktop system 10) or provides an instruction to an attached printing
  device (col. 3, lines 52-53, attached printer, col. 6, line 10, line 25, printer)
  associated with the computer by detecting a characteristic of the e-mail, wherein
  the received message does not include print data to be printed by the attached
  printing device and the instruction is unrelated to printing of data included in or
  attached to the received message (see col. 8, lines 4-10, the message
  characteristics ("instruction") that determine whether a message is to be
  redirected to attached printer);

- transmitting a communication from the computer (user's desktop system 10) to
  the attached device (a mobile data communication device), if the determining
  step determines that the received message provides the instruction (col. 8, lines

5-10, the message characteristics) to the attached printing device (col. 3, lines 52-53, attached printer, col. 6, line 10, line 25, printer) (see abstract, determining a system for pushing information from a host system (a computer) to a mobile data communication device (a business device) upon sensing a triggering event is disclosed (see abstract). A redirector program operating at the host system (a computer) enables a user to continuously redirect certain user's mobile data communication device upon detecting the one or more user-defined triggering events has occurred (see abstract); (see col. 8, lines 9-11, a list of message characteristics that determine whether a message is to be redirected. If activated, the preferred list mode causes the redirector program 12 to operate like a filter, only redirecting certain user data items based on whether the data item was sent from a sender on the preferred list or has certain message characteristics that if present will trigger or suppress redirection of the message).

- operating the processor of the attached device (a mobile data communication device) in response to the transmitted communication (once the message (A or B) is received by the mobile device 24); the outer envelope B is removed and the original message A is placed in the secondary memory store within the mobile device 24. By repacking and removing the outer envelope in this manner, the present invention causes the mobile computer 24 to appear to be at the same physical location as the host system 10, thus creating a transparent system);

- control of attached image printing device associated with the computer; and transmitting a communication from the computer to the attached image printing

device (col. 3, lines 52-53, the redirector routes these attachments to an external machine that is compatible with the particular attachment, such as an attached printer or networked fax machine) (col. 3, lines 10-15, col. 3, lines 52-53, determined by the redirector whether the content of the E-mail is for the attached printer or network fax machine)

However, Lazaridis et al. is silent to disclosing that the attached printing device including a processor.

Chapman (U.S.Patent No. 6,522,421 B2) discloses that the attached printing device including a processor (figure 1, copier / printer 15', 15", col. 2, lines 58-60, microprocessors), operating the processor of the attached printing device in response to the transmitted communicaiton (col. 3, lines 15-17, lines 57-58, the email message or electronic mail may be transmitted by telephone lines to computers that are coupled to the printers) so that the printer will perform a print job and email back status information (col. 3, lines 5-6, a method of automatically returning status and error information from a printer using email).

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Lazaridis with the teaching of Chapman to provide the attached printing device including a processor in order to diagnose of troubles in such devices. Therefore, it would have enabled the user to be informed of the status of print job.

8.   In the claims 2, 24, Lazaridis et al. discloses determining whether the received message includes instructions (the word "instruction" is the characteristic of the e-mail)

for operating the device or whether the received message which has been received has

been received has a user of the computer as an end recipient (see abstract, col. 8, lines

9-11).

9.   In the claim 8, Lazaridis et al. discloses receiving an Internet electronic mail

message (see abstract, col. 8, lines 9-11, figure 1).

10.   In the claim 45, Lazaridis et al. discloses receiving data from the device, in

response to the step of operating the processor; creating an electronic mail message

(repackage the user-selected data items in an electronic wrapper prior to push the data

items to the mobile device) by computer (the user's desktop system 10) including the

data which has been received; and transmitting over the Internet the electronic mail

message generated by the computer.

11.   In the claims 46, 50, 51, Lazaridis et al. discloses executing, by a device driver

of the computer, commands for at least one of controlling and monitoring the device

(see col. 1, lines 11-15, the system and method of the present invention provide an

event-driven redirection computer program ("redirector program") operating at the host

system, which, upon sensing a particular user-defined event has occurred, redirects

user-selected data items from the host system to the user's mobile data communication

device (Business office device including CPU) (col. 7, lines 14-15).

12.   In the claims 48, 32, Chapman, see figure 3, discloses Executing a command

which causes the step of transmitting to be performed (see figure 3, col. 3, lines 5-7).

13.   In the claim 10, Lazaridis discloses receiving, by the device, the communication

transmitted from the computer; and transmitting parameters from the device to the

computer, in response to the communication which has been received by the device (see col. 6, lines 42-45).

14.   In the claims 13, 35, 36, 37, 52, Lazaridis discloses determining that the message for operating the attached device automatically by detecting a code within the message (see col. 8, lines 9-11, a list of message characteristics that determine whether a message is to be redirected. If activated, the preferred list mode causes the redirector program 12 to operate like a filter, only redirecting certain user data items based on whether the data item was sent from a sender on the preferred list or has certain message characteristics that if present will trigger or suppress redirection of the message).

15.   In the claim 14, Lazaridis discloses determining that the message for operating the attached device automatically by detecting a code which is the subject of the message (see col. 8, lines 9-11, a list of message characteristics that determine whether a message is to be redirected. If activated, the preferred list mode causes the redirector program 12 to operate like a filter, only redirecting certain user data items based on whether the data item was sent from a sender on the preferred list or has certain message characteristics that if present will trigger or suppress redirection of the message).

16.   In the claim 15, Lazaridis discloses determining that the message is for the attached device automatically by detecting a code within the message (see col. 8, lines 9-11, a list of message characteristics that determine whether a message is to be redirected. If activated, the preferred list mode causes the redirector program 12 to

operate like a filter, only redirecting certain user data items based on whether the data

item was sent from a sender on the preferred list or has certain message characteristics

that if present will trigger or suppress redirection of the message).

Claim Rejections - 35 USC § 103

17.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed
> or described as set forth in section 102 of this title, if the differences between the
> subject matter sought to be patented and the prior art are such that the subject
> matter as a whole would have been obvious at the time the invention was made
> to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was
> made.

18.   Claims 11, 16-17, 30, 33, 38-39 are rejected under 35 U.S.C. 103(a) as being

unpatentable over the combined system (Lazaridis – Chapman) in view of Zerber

(U.S.Patent No. 5,951,636).

In the claim 11, the combined system (Lazaridis – Chapman) discloses the

limitations of claim 1 above.

However, the combined system (Lazaridis – Chapman) is silent to disclosing

performing a mechanical action by the device, in response to the communication which

has been received by the device.

Zerber et al. performing a mechanical action by the device, in response to the

communication which has been received by the device (see abstract).

Both Lazaridis, Chapman, and Zerber discloses e-mail message. Zerber

discloses executing program code of a file which is attached to the message by a

manual action by the user. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system (Lazaridis – Chapman) with the teaching of Zerber to executing program code of a file which is attached to the message by a manual action in order to limit to only those messages the user want to downloaded.

19.   Regarding to claims 16, 17, 30, 38, 39, Zerber et al. discloses the determining step is performed in response to a receipt of an incoming electronic mail message (see col. 2, lines 30-65).

20.   In the claim 33, the combined system (Lazaridis – Chapman) discloses the limitations of claim 1 above.

However, the combined system (Lazaridis – Chapman) is silent to disclosing performing a mechanical action by the printing device, in response to the communication which has been received by the printing device.

Zerber discloses performing a mechanical action by the printing device, in response to the communication which has been received by the printing device (see abstract) (see col. 2, lines 30-65).

Both Lazaridis, Chapman, and Zerber discloses e-mail message. Zerber discloses executing program code of a file which is attached to the message by a manual action by the user. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system (Lazaridis – Chapman) with the teaching of Zerber to executing program code of a file which is

attached to the message by a manual action in order to limit to only those messages the

user want to downloaded.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

21.　　Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over the

combined system (Lazaridis – Chapman) in view of Miyachi (U.S.Patent No.

6,108,492).

Regarding to claim 47, the combined system (Lazaridis - Chapman) discloses

the limitations of claim 1 above.

However, the combined system (Lazaridis - Chapman) is silent to disclosing the

business office device at least one of generates an image on a recording medium and

scans an image on a recording medium.

Miyachi discloses wherein the business office device at least one of generates an

image on a recording medium and scans an image on a recording medium (see col. 2,

lines 27-35).

Both Lazaridis, Chapman, and Miyachi disclose the office deive. Miyachi

discloses the business office device at least one of generates an image on a recording

medium and scans an image on a recording medium. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system (Lazaridis - Motoyama) with the teaching of Miyachi to provide the business office device at least one of generates an image on a recording medium and scans an image on a recording medium in order to carry out remote diagnose of troubles in business communication devices.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHUONG T. HO whose telephone number is (571) 272-3133. The examiner can normally be reached on 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ORGAD EDAN can be reached on (571) 272-7884. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

08/10/07

EDAN Ð. ORGAD
SUPERVISORY PATENT EXAMINER
8/15/07